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In re Application of :
Araki et al. :
Application No.: 09/095,842 :
Filed: June 11, 1998 :
For: AQUEOUS DISPERSION OF VINYLIDENE :
FLUORIDE POLYMER AND :
PREPARATION PROCESS THEREOF :

OFFICE OF PETITIONS

**DECISION ON
PETITION**

This is a decision on the petition under 37 CFR 1.181(a)(3) filed on September 22, 2004, requesting that the supervisory authority of the Director be invoked to review the action of the Group Director of Technology Center 1700 (Group Director) which authorized reopening of prosecution subsequent to the decision of the Board of Patent Appeals and Interferences.

The petition under 37 CFR 1.181(a)(3) to rescind and withdraw the reopening of prosecution subsequent to the decision of the Board of Patent Appeals and Interferences is **DENIED**.

BACKGROUND

The final rejection of May 8, 2002, contained rejections of claims 6 through 11 under 35 U.S.C. § 112, first paragraph as lacking enablement; a rejection of claims 6 through 11 under 35 U.S.C. § 112, first paragraph as lacking enablement with respect to the lack of inclusion of the non-ionic, non fluorine-containing compound ; a rejection of claims 12 through 14 under 35 U.S.C. § 112, first paragraph as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art, *i.e.*, lacking description of "an average particle size of not more than 320.1 nm"; and a rejection of claims 15 through 17 under 35 U.S.C. § 112, first paragraph as lacking description of "an average particle size of not more than 196.3 nm." All claims were thus rejected on formal grounds.

On August 8, 2002, applicants filed a Notice of Appeal, followed on December 9, 2002 by applicants' Appeal Brief (Brief) and a petition and fee for an extension of time.

On February 21, 2003, the Examiner's Answer (Answer) was mailed. The Answer maintained the rejections under 35 U.S.C. § 112, first paragraph, noted above.

On April 19, 2004, the Board of Patent Appeals and Interferences (BPAI) issued a decision that (at 2) characterized the rejections under 35 U.S.C. § 112 paragraph 1 before it as being that: (1) claims 6 through 11 were rejected for lack of enablement, and (2) claims 6 through 17 were rejected for lack of written description. The decision affirmed the rejections of claims 6 through 11 for lack of enablement, and reversed the rejections of claims 6 through 17 for lack of description.

On June 18, 2004, applicants filed an amendment that canceled claims 6 through 11 and amended claims 12 through 17.

On July 22, 2004, a non final Office action was mailed which reopened prosecution by rejecting claims 12 through 17 under 35 U.S.C. § 112, first paragraph as lacking enablement. The Office action (at 3) was signed, *inter alia*, by the Group Director.

On September 22, 2004 applicants filed the instant petition seeking that the reopening of prosecution by way of the Office action of July 22, 2004, be vacated on the grounds that such lacked compliance with 37 CFR 1.198.

On January 21, 2005, applicants filed a reply to the outstanding Office action and a petition for an extension of time.

STATUTE, REGULATION, AND EXAMINING PROCEDURE¹

35 U.S.C. § 2(b) provides, in pertinent part, that:

The USPTO.....may, subject to the policy direction of the Secretary of Commerce, establish regulations, not inconsistent with law, which shall govern the conduct of proceedings within the USPTO.

37 CFR 1.198 provides that:

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or 1.196 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

MPEP 1214.04 states in pertinent part:

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the

¹Manual of Patent Examining Procedure, ("MPEP") (8th Ed.. Rev. 2, May 2004)

examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

The examiner may request rehearing of the Board decision. Such a request should normally be made within 2 months of the receipt of the Board decision in the TC. The TC Director's secretary should therefore date stamp all Board decisions upon receipt in the TC.

All requests by the examiner to the Board for rehearing of a decision must be approved by the TC Director and must also be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for approval before mailing.

The request should set a period of 1 month for the appellant to file a reply.

If approved, the Office of the Deputy Commissioner for Patent Examination Policy will mail a copy of the request for rehearing to the appellant. After the period set for appellant to file a reply (plus mailing time) has expired, the application file will be forwarded to the Board.

OPINION

Petitioners contend that the reopening of prosecution lacks compliance with 37 CFR 1.198 in that "sufficient cause" has not been shown; that the issues raised by the Office action mailed July 22, 2004, set forth matters already adjudicated by the BPAI such that prosecution cannot be reopened.

While it is unfortunate that the examiner did not earlier present the current rejection of claims 12 through 17 on the grounds of lack of enablement, such that the BPAI could have all issues before it when the decision of April 19, 2004, was rendered, the reopening of prosecution herein is neither improper under or inconsistent with 37 CFR 1.198.

Since the record shows that the examiner did not expressly reject claims 12 through 17 under 35 U.S.C. § 112, first paragraph as lacking enablement in his Answer, that rejection of those claims was not before the BPAI. See In re Bush, 131 USPQ 263, 267 (CCPA 1961) ("it seems to us that the words "grounds specified by the examiner" must be construed to include all grounds relied on at final rejection and not clearly withdrawn by the examiner's answer, notwithstanding what appears to be an office practice (which may find support in M.P.E.P. 1208) to regard grounds of rejection not *repeated* in the answer as withdrawn by implication"). This conclusion is reinforced by consideration of: (1) the language actually employed in the examiner's statement of the rejections of claims 12 through 17, *i.e.* "as containing subject matter which was **not described** in the specification in such a way..." (emphasis added), (2) applicants' contemporaneous characterization of the rejection of claims 12 through 17 as being on the grounds of lack of

description, see appellants' Brief filed December 9, 2002, (at 7) ("[t]he first rejection of claims 6-11...involves the enablement requirement...the remaining three rejections;... including the rejection of claims 12-14. and...15-17 involve the **description** requirement"(emphasis added)), and (3) the BPAI's own characterization of the second ground of rejection of claims 12 through 17. See BPAI decision mailed April 20, 2004 (at 2)("2. [c]aims 12-17 stand rejected for lack of **descriptive** support."(emphasis added)).

Further, the fact that the examiner did not did not reject claims 12 through 17 under 35 U.S.C. § 112, first paragraph, as lacking enablement on the same grounds that he applied when he rejected claims 6 through 11 under 35 U.S.C. § 112 first paragraph as lacking enablement, or when he rejected claims 6 through 17 under 35 U.S.C. § 112, first paragraph as lacking description, is not an admission of patentability on those grounds, or even an estoppel against the examiner. See In re Freeman, 76 USPQ 585, 586 (CCPA 1948)(examiner not precluded from reopening and rejecting on specific ground that was made and withdrawn prior to BPAI decision).²

Likewise, and contrary to petitioners' contention, the fact that the rejection of claims 12 through 17 under 35 U.S.C. 112, paragraph 1 on the grounds of lack of description was reversed does not give rise to a *res judicata* effect on the enablement issue. See Id. Nor does the examiner's lack of earlier presentation of the contested lack of enablement rejection for claims 12 through 17 give rise to a *res judicata* effect. Id. It is noted that the written description requirement is separate and distinct from the enablement requirement. See In re Barker, 559 F.2d 588, 194 USPQ 470 (CCPA 1977), *cert. denied*, 434 U.S. 1064 (1978); Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991). Specifically, the fact that a given claim may have adequate description in the specification does not mean that, *ipso facto*, that claim also has adequate enablement. See In re Armbruster, 512 F.2d 676, 677, 185 USPQ 152, 153 (CCPA 1975)("[A] specification which 'describes' does not necessarily also 'enable' one skilled in the art to make or use the claimed invention.") Thus, the BPAI decision on the propriety of the rejection of claims 6 through 17 under 35 U.S.C. 112, first paragraph, as lacking adequate description is not dispositive of the issue as to whether claims 12 through 17 are adequately enabled as required by 35 U.S.C. § 112 first paragraph. Accordingly, the reopening of prosecution was not inconsistent with 37 CFR 1.198.

The USPTO's reviewing courts have specifically held that even a court decision reversing a rejection does not preclude further examination of the application by the USPTO subsequent to the examination provided for in 35 U.S.C. §§ 131 and 132 and the BPAI and court review

² It is noted that in Freeman, the reopening of prosecution set forth, *inter alia*, a ground of rejection (double patenting) that had been made earlier in prosecution, but had not been repeated in the final rejection, and, as such, was not an issue considered in the first appeal. After this rejection was affirmed by the Board of Appeals in the second appeal, counsel for Freeman argued unsuccessfully to the court that the circumstances suggested that this ground of rejection had not initially been repeated due to its "doubtful propriety." The CCPA noted that the rejection was nevertheless properly before it for consideration on the merits, and likewise affirmed. Id.

provided for in 35 U.S.C. §§ 134 and 141. See Jeffrey Mfg. Co. v. Kingsland, 83 USPQ 494, 494 (D.C. Cir. 1949); see also In re Gould, 213 USPQ 628, 629 (CCPA 1982) (USPTO can always reopen prosecution in an application under an *ex parte* court appeal once it regains jurisdiction over the application); In re Arkley, 172 USPQ 524, 527 (CCPA 1972) (the USPTO is free to make such other rejections as it considers appropriate subsequent to a court decision reversing a rejection); In re Fisher, 171 USPQ 292, 293 (CCPA 1971) (reversal of rejection does not mandate issuance of a patent); In re Ruschig, 154 USPQ 118, 121 (CCPA 1967) (subsequent to a court decision reversing a rejection, the USPTO may reopen prosecution and reconsider previously withdrawn rejections that are not inconsistent with the decision reversing the rejection); In re Citron, 140 USPQ 220, 221 (CCPA 1964) (following decision reversing a rejection of claims, the USPTO has not only the right but the duty to reject claims deemed unpatentable over new references); Hull v. Commissioner, 9 D.C. (2 MacArth.) 90 (D.C. 1875) (mandamus to issue patent denied, notwithstanding that Commissioner withdrew an application from issue after favorable decision by the board of examiners-in-chief and after payment of the issue fee). It follows, *a fortiori*, that the 37 CFR 1.198 does not require the USPTO to limit the reopening of prosecution under 37 CFR 1.198 to evidence not previously relied on.³ It is well established that if there is any substantial, reasonable ground within the knowledge or cognizance of the Director why the application should not issue, the Director has the duty, much less the authority, to refuse to issue the application. See In re Drawbaugh, 9 App. D.C. 219, 240 (D.C. Cir 1896).

The authority to permit, under 37 CFR 1.198, the reopening of prosecution subsequent to a decision by the BPAI has been delegated to the Group Director. See MPEP 1002.02(c), ¶ 1. Since the office action that reopened prosecution was signed by the Group Director, thus indicating his approval, the statement of the rejections in that Office action is all the justification required under 37 CFR 1.198 for reopening prosecution. See Drawbaugh, supra. While petitioner is understandably unhappy with the reopening, as noted in Citron, 140 USPQ at 221:

While appellant may have just cause for complaint that the Patent Office should have operated more effectively in finding the closest prior art...this is of no moment whatever in deciding appellant's legal right to the appealed claims in the face of the new prior art now that it has been cited.

Petitioners' remaining arguments are, in essence, that the contents of the Office action, or the form of the rejection and its supportive reasoning, or both, are facially insufficient to demonstrate sufficient cause for reopening of prosecution. Nevertheless, as such arguments go more to the merits of the rejection set forth in that Office action, as opposed to the procedural question of

³ As noted in In re Hilmer, 359 F.2d 859, 879, 149 USPQ 480, 496 (CCPA 1966):

Much confused thinking could be avoided by realizing that rejections are based on statutory provisions, not on references, and that the references merely supply the evidence of lack of novelty, obviousness, loss of right or whatever may be the ground of rejection.

reopening by way of that Office action, they will not be further addressed on petition. See Boundy v. U.S. Patent & Trademark Office, 73 USPQ2d 1468 (DC EVa 2004), *appeal dismissed*, 2004 U.S. App. LEXIS 26384 (Fed. Cir. 2004). Any review of the rejection of which petitioner complains (and its underlying reasoning) is limited to a merits appeal as provided by 35 U.S.C. § 134, and not by way of petition. Id. It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the BPAI. See In re Dickerson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971).

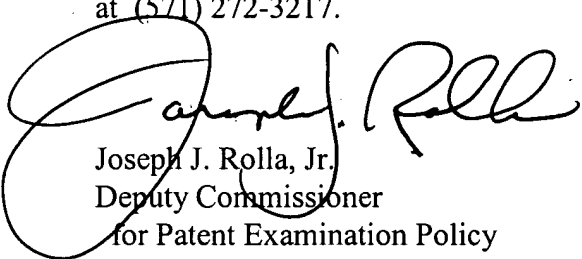
DECISION

The instant petition is granted to the extent that the action of the Group Director has been reviewed, but is **denied** as to making any change therein. As the reopening of prosecution was not inconsistent with 37 CFR 1.198, the Group Director's decision will not be disturbed. The Office action of July 22, 2004, which reopened prosecution remains in full force and effect and will not be vacated.

In any event, assuming *arguendo*, that, per MPEP § 1214.04, the Office action of July 22, 2004, requires the approval of the Deputy Commissioner for Patent Examining Policy, such approval is hereby given.

This decision may be regarded as a final agency action within the meaning of 5 U.S.C. § 704.

Telephone inquiries concerning this decision may be directed to Petitions Examiner Brian Hearn at (571) 272-3217.



Joseph J. Rolla, Jr.
Deputy Commissioner
for Patent Examination Policy